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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,451	04/24/2001	Kumiaki Kawamura	199/49908	1890
23911	7590	02/17/2004	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/840,451	KAWAMURA ET AL.
	Examiner	Art Unit
	Igor Borissov	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 24 April 2001.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_ .

## DETAILED ACTION

### *Specification*

Abstract is presented in improper form. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 1.**

the terms "heat/cold heat" and "heat and cold heat" are confusing;  
the term "the amount of the heat" lacks antecedent basis;  
the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d);  
the phrase "etc" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d);  
the term "or" in the frase "the Internet, Intra-net, **or** dialup" makes the claim indefinite because it is unclear what type of communication is actually used;  
the term "replace by a different class one" is confusing;  
the term "the heat/cold heat load" lacks antecedent basis.

**Claim 2.**

the term "heat/cold heat" is confusing;  
the term "the unit leased" lacks antecedent basis;  
the term "the cumulative level" lacks antecedent basis;  
the term "the prescribed upper limit" lacks antecedent basis;

**Claim 3.**

the term "heat/cold heat" is confusing;  
the term "the cumulative level" lacks antecedent basis.

**Claim 4.**

the term "heat/cold heat" is confusing;  
the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d);  
the term "these data" is confusing.

**Claim 5.**

the term "heat/cold heat" is confusing.

**Claim 6.**

the term "heat/cold heat" is confusing;  
the term "the payment" lacks antecedent basis;  
the phrase "charge for fluctuating heat/cold heat corresponding to fluctuating loads" is confusing.

**Claim 7.**

the term "heat/cold heat" is confusing;  
the term "the payment" lacks antecedent basis;  
the term "the rental" lacks antecedent basis.

**Claim 8.**

the term "heat/cold heat" is confusing;  
the term "the payment" lacks antecedent basis;  
the term "the management fee" lacks antecedent basis;  
the term "the maintenance" lacks antecedent basis;  
the phrase "etc" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d);  
the term "irregularity" is not clear.

**Claim 9.**

the term "heat/cold heat" is confusing;  
the term "irregularity" is not clear.

**Claim 10.**

the term "heat/cold heat" is confusing;

**Claim 11.**

the term "heat/cold heat" is confusing.

**Claim 12.**

the term "heat/cold heat" is confusing.

Also,

**Claim 12** is confusing, because **claim 12** cites the limitations of **claim 11** while referring to **claim 1**.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nierlich et al. (US 2003/0158632) in view of Grinblat (US 4,902,322).**

Nierlich et al. teach a method and system for monitoring and controlling energy distribution, comprising:

**Claim 1.** An energy management system comprising means for monitoring energy consumed by the user (including HVAC units) over the Internet, wherein the user is notified about power curtailment events in accordance with the variation of the load, and wherein the power curtailment events include providing a listing of load reduction/displacement items including HVAC units [0037]; [0066]; [0074].

Nierlich et al. do not specifically teach that the power curtailment events include installing additional heating or cooling unit (hereafter referred to as unit) or reducing the number of existing units in accordance with the variation of the heat/cold heat load.

Grinblat teaches a method and system for supplemental air conditioning units for building, wherein a tenant who requires a lower temperature in his premises may install the supplemental unit (column 4, lines 64-68).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich et al. to include that the power curtailment events include installing additional heating or cooling units, because it would allow to solve the local environmental needs of individual tenants without costly renovating of whole building heating system, thereby saving funds.

**Claim 2.** Lease of premises in Grinblat obviously indicates lease of said unit (column 1, line 67 – column 2, line 4).

**Claim 3.** See claim 1.

**Claim 4.** Nierlich et al. teach said method and system, comprising a network (the Internet) and servers which include monitoring circuitry for monitoring the amount of power used and to maintain power curtailment events [0037]; [0046]; [0049]; [0085].

**Claim 5.** Nierlich et al. teach said method and system, comprising a management device (10) for monitoring the amount of power used and to maintain power curtailment events [0049].

**Claim 6.** Nierlich et al. teach said method and system, in which the user is charged for the energy used and wherein charges reflect fluctuating power usage [0066].

**Claim 7.** Grinblat teaches said method and system, wherein a supplemental unit is installed at the leased by the tenant space (column 2, lines 1-2). The leased space obviously indicates leased supplemental unit.

**Claim 8.** Nierlich et al. teach said method and system, in which the user is charged a fee for the energy used [0066].

However, Nierlich et al. do not specifically teach that said fee include a management fee for the maintenance.

Official notice is taken that it is well known that any equipment needs a regular maintenance to operate properly.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich et al. and Grinblat to include that said fee for the energy used include management fee for the maintenance, because it would provide the required funds to maintain the units in proper working order.

**Claim 9.** Nierlich et al. teach said method and system, including pictorial data showing the operating condition of the unit (Fig. 13).

**Claim 10.** See claim 8.

**Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nierlich et al. and Grinblat in view of Houlihan (US 5,351,712).**

**Claim 11.** Grinblat teaches said method and system, wherein the supplemental unit may be installed at the tenant premises (column 4, lines 64-68).

However, Grinblat does not specifically teach that said unit is a portable unit.

Houlihan teach a hot water recovery method and apparatus, wherein said apparatus may be implemented as a portable unit, and may be temporarily installed by lessees or leased structures who desire reduce utility costs by saving energy consumption (column 14, lines 7-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Nierlich et al. and Grinblat to include that said unit is a portable unit, because it would simplify the installation processes of this unit as well as decrease costs associated with it.

**Claim 12.** Grinblat teaches said method and system, wherein the supplemental unit may be installed at the tenant premises (column 4, lines 64-68).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

Art Unit: 3629

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

*JB*

*gw*

JOHN G. WEISS  
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